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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/769,794	01/25/2001	Steven J. Sanders	CITI0211	4092
27510	7590	04/29/2005	EXAMINER	
KILPATRICK STOCKTON LLP 607 14TH STREET, N.W. WASHINGTON, DC 20005			WEISBERGER, RICHARD C	
			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 04/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/769,794	Applicant(s) JOHNSON, JEFFERY L.
	Examiner Richard C Weisberger	Art Unit 3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on ____.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-91 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) Claim(s) ____ is/are allowed.
- 6) Claim(s) 1-91 is/are rejected.
- 7) Claim(s) ____ is/are objected to.
- 8) Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on ____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. ____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. ____.
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date ____.	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-48 and 91 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Technology is required in the body of the claim. In a non-trivial manner, each claim must be directly tied to the technological arts. The claims as drafted can read on a oral communication.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

3. Claims 1-4,7,8,23,24,25,26,27,28,29,30,34,35,36,37,38,39,40,41,42,43,44,45,46-49,52,53,68-75,79,80,81,82,84,85-90 are rejected under 35 U.S.C. 102(a) as being anticipated by Minton USP #6014643.

The reference is directed to a method and apparatus for trading financial instruments. Figure 400 and the accompanying text describe the features of the cited claims. The applicant has filed 90+ claims that but for the type of instrument being traded read on prior art trading systems. The applicant has attempted to distinguish the claims with a limitation directed to “customizable investment product” (method independent claim 1 and apparatus independent claim 46). The broadest reasonable interpretation of the

limitation a customizable investment product, includes, many regularly traded financial instruments, such as preferred stocks and vanilla options, securities inherent in the teaching of Minton. While the applicant's specification is directed to a trading method and apparatus designed to handle a principal protected notes, each of the limitations of the cited claims read on the prior art electronic trading interface and network designed to handle plain vanilla securities, options and futures. The examiner takes official notice as to any limitation of the cited claims not directly taught by Minton and contends that each of these features are inherent to prior art system as a whole.

Claim Rejections - 35 USC § 103

4. Claims 1-91 are rejected under 35 U.S.C. 103(a) as being unpatentable over Minton USP 6014643 in view of Pr News Wire, CBOE Begins Trading Index Linked Principal Protected Notes.

The prior art discussed above fails to teach the limitations specifically directed to a principal protected note such as displaying a list which includes at least one of an individual equity related contract with downside protection, a leveraged individual equity contract with limited downside, an equity index contract with an index payout plus a contracted premium, and a collar protection contract for use with an existing equity position with downside protection, receiving a selection of terms for the customizable investment product for the investor, selected from a group of terms consisting of a maturity and a protection level for the individual equity related contract, a maturity and a leverage factor for the leveraged individual equity contract, and an index and a sum to

invest. The secondary reference teaches that the CBOE has been trading Principal Protected Equity Linked Notes as of 1998. It would have been obvious for one skilled in the art at the time to have modified the system of Minton to handle the Notes of the secondary reference as motivated by the need to increase liquidity, a well known art recognized variable in securities trading. As to the limitations directed to search strategies of identifying these notes by one or more criteria, it would have been obvious for one to have modified the system of Minton with these features, again as motivated by the need to increase liquidity and the like. The examiner takes official notice that add on stock screening modules are well known in the art.

5. This Office action has an attached requirement for information under 37 CFR 1.105. A complete reply to this Office action must include a complete reply to the attached requirement for information. The time period for reply to the attached requirement coincides with the time period for reply to this Office action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard C Weisberger whose telephone number is 703 308 4408.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vince Millin can be reached on 703 308 1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Richard C Weisberger
Primary Examiner
Art Unit 3624

6. Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.

7. The information is required to document the level of skill and knowledge in the art of trading principal protected notes.

8. The information is required to identify products and services embodying the disclosed subject matter of trading principal protected notes and identify the properties of similar products and services found in the prior art. In response to this requirement, please provide the names of any products or services that have incorporated the claimed subject matter.

9. In response to this requirement, please provide the names of any products or services that have incorporated the disclosed prior art trading of principal protected notes, CybicBulls, CybicBears, CybicProtects, CybicFunds, CyubicSecure and other similar products.

10. In responding to those requirements that require copies of documents, where the document is a bound text or a single article over 50 pages, the requirement may be met by providing copies of those pages that provide the particular subject matter indicated in the requirement, or where such subject matter is not indicated, the subject matter found in applicant's disclosure.

11. The fee and certification requirements of 37 CFR 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those

documents within the scope of this requirement under 37 CFR 1.105 that are included in the applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope of this requirement under 37 CFR 1.105 are subject to the fee and certification requirements of 37 CFR 1.97.

12. The applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56. Where the applicant does not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained will be accepted as a complete reply to the requirement for that item.

13. This requirement is an attachment of the enclosed Office action. A complete reply to the enclosed Office action must include a complete reply to this requirement. The time period for reply to this requirement coincides with the time period for reply to the enclosed Office action.

Richard Weisberger
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